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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,468	12/14/2001	Christopher S. Moore	10519/75	3569

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EXAMINER

ELMORE, STEPHEN C

ART UNIT	PAPER NUMBER
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2186

11

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. .

10/023,468

Applicant(s)

MOORE ET AL.

Examiner

Stephen Elmore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 14, 2001 - June 7, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 and 28-36 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-22, 24-27 and 37-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 14, 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 and 6-10.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-49 are presented for examination.
2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

3. The drawings are objected to because:

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

More specifically,

- a. Figure 1 is described in the Brief Description of the Drawings as "an illustration of a page of memory of a preferred embodiment in accordance with a mode set forth in the Smart Media specification";

however,

- b. in the discussion of this figure in relation to the present invention (Detailed Description, page 3 - page 5, line 2), the entire contents of Figure 1 is not described as including any novel features of the instant invention, the entire discussion of the significance of Figure 1 only addresses features which are in the prior art, i.e., the contents of Figure 1 only show the exact same information as is depicted in, for example, Figure 2-5 of the prior art document "Smart Media Physical Format Specifications Version 1.30," and the discussion fails to attribute any novel feature of the instant invention to this figure, other than simply asserting that it

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(somehow) is an embodiment of the present invention, therefore, Figure 1, by itself, doesn't appear to be an embodiment of the present invention but only appears to contain features representing Prior Art insofar as what it actually shows.

Examiner's Notes:

1) if Applicant should not agree with the above interpretation, in his response, Applicant is requested to specifically point-out the novel features of the instant invention contained in Figure 1;

2) in interpreting the scope of the present invention, the Examiner considers drawings showing only prior art features to represent Prior Art, if Figure 1 only truly shows prior art features, then a Prior Art label is required in order to distinguish what the Applicant invented as opposed to what the prior art teaches.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the process method steps of claims 1-49, which may be in the form of flowcharts, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional

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replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:
 - a. references to patent applications within the specification should be updated to reflect their current status, now patented, now abandoned, etc.

Appropriate correction is required.

Claim Objections

5. Claims 1-22, 24-27, 37-44, and 45-49 are objected to because of the following informalities:
 - a. claims 1, 3, 4, 6-10, 18, 19, 21, 24, 25, 27, 37, 40, 41, 45, 47, 48, 49, "the memory device" lacks proper antecedent basis;
 - b. claims 2, 5, 11-17, 20, 22, 26, 38, 39, 42-44, and 46 inherits the deficiencies of the preceding claim in the claim dependency chain.

Appropriate correction is required.

Allowable Subject Matter

6. Claims 23 and 28-36 appear allowable over the prior art of record.

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7. Claims 1-22, 24-27, and 37-49 contain allowable subject matter over the prior art of record, however, are not presently allowable, because they remain objected-to for the above given reasons.

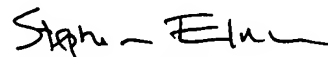
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (703) 308-6256. The examiner can normally be reached on Mon-Fri from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen Elmore
Patent Examiner
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June 27, 2004